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DAVIS LAW GROUP, P.C.
6836 BEE CAVES ROAD
SUITE 220
AUSTIN, TX 78746

EXAMINER
LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 March 2007*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,2,4-7,9-12 and 14-30* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 2, 4-7, 9-12, and 14-30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the after-final amendment received 3/13/2007.

2.   Claims 1, 2, 4-7, 9-12, and 14-30, are pending in the application. Claims 1, 6, 11, 19, 20,

24, 25, 29, and 30, are independent claims.

3.   Claims 1, 2, 4-7, 9-12, and 14-30, rejected under 35 U.S.C. 103(a) as being unpatentable

over Kuppusamy et al., have been withdrawn pursuant to applicant's amendment.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   **Claims 1, 2, 4-7, 9-12, and 14-30, are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Schilit et al., USPN 6,356,922 filed (6/19/1998).

In reference to dependent claim 1, Schilit teaches:

Figure 4a illustrates a source document input in the system, segmented, and stored

(compare to "*storing a version of a paper, the version being displayable on a display device as*

a likeness of the paper"). See Schilit, figure 4a, and column 5, lines 8-32. The reference teaches

a method of storing a version of a paper through the control routine.

The control routine determines whether an annotation has been input into the system. The

annotation may be input in any number of different ways using any number of different systems.

One preferred method of inputting an annotation is by marking directly on a display of the source

document (compare to "*at a first location within the version, detecting a reference to a second location, wherein the detected reference....*"). See column 5, lines 21-45.

The control routine then continues to step where links to each of the identified target portions are displayed. If the link corresponds to a target portion that is related to the context of a particular annotation then the link is displayed in a margin adjacent to the annotations as a margin representation. Figure 2 illustrates a hyperlink embedded within the detected reference (compare to "*in response to the detected reference, embedding a hyperlink within the detected reference*"). See column 6, lines 1-38.

The reference provides a means of embedding links based upon annotations made to a source document. Based upon the annotations, the link is embedded next to the segment of text in the source document. The reference fails to explicitly state 'highlighting the first location to indicate the hyperlink'. The reference, instead, chooses to embed the hyperlink and highlight the hyperlink utilizing an icon directly next to the first location. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the well-known link embedding methods of Schilit and modified the reference to provide the link within the text at the end of the text if the annotation was created at the end of the text and associated with a specific last segment. If the end note was produced in response to the annotation at the end of the segment than it would suggest a means of embedding a link within a first location thereby minimizing the explicit query required to identify portions of other documents.

In reference to dependent claim 2, 4, and 5, Schilit teaches:

The control routine then continues to step where links to each of the identified target

portions are displayed. If the link corresponds to a target portion that is related to the context of a

particular annotation then the link is displayed in a margin adjacent to the annotation as a margin

representation. Alternatively, if the control routine identifies a target portion that is related to the

source document as a whole then the control routine displays a link to the target portion as an

end note. See column 6, lines 1-18.

In reference to dependent claim 6, 7, 9, and 10, the system claims recite similar instructions

for performing the embedding hyperlink methods as those performed in claims 1, 2, 4, and 5,

respectively. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 11, 12, 14, and 15, the computer program product claims

recite similar instructions for performing the embedding hyperlink methods as those performed

in claims 1, 2, 4, and 5, respectively. Therefore, the claims are rejected under similar rationale.

In reference to dependent claim 16 and 17, Schilit teaches:

The control routine analyzes the context of the annotation and generates a query that will

be used to search the database of target portions. The system and method of this invention

derives the query from the text of the annotated passage and from the nature of the annotation. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have utilized the well-known context analysis methods taught by Schilit to create annotations

pointing out advertisements or any other text that would be appropriate to a user's interest and

creating a link to that advertisement if that was of interest to a specific user for minimizing the

explicit query required to identify portions of other documents.

In reference to dependent claim 18, Schilit teaches:

The reference provides a means of embedding links based upon annotations made to a source document. Based upon the annotations, the link is embedded next to the segment of text in the source document. The reference fails to explicitly state 'a file external to the paper, wherein the file includes visual image information'. The reference, instead, chooses to embed the hyperlink and highlight the hyperlink utilizing an icon directly next to the first location. Furthermore, the control routine then continues to step where links to each of the identified target portions are displayed. If the link corresponds to a target portion that is related to the context of a particular annotation then the link is displayed in a margin adjacent to the annotation as a margin representation. Alternatively, if the control routine identifies a target portion that is related to the source document as a whole then the control routine displays a link to the target portion as an end note. See column 6, lines 1-18.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the well-known link embedding methods of Schilit and modified the reference to provide the link within the text at the end of the text if the annotation was created at the end of the text and associated with a specific last segment. If the end note was produced in response to the annotation at the end of the segment than it would suggest a means of embedding a link within a first location thereby minimizing the explicit query required to identify portions of other documents.

In reference to independent claim 19 and 20, Schilit teaches:

It is to be understood that the term annotation as used herein is intended to include text, digital ink, audio, video or any other input associated with a document. It is also to be understood

that the term document is intended to include text, video, audio, and any other media and any combination of media (compare to "embedding a hyperlink within the detected reference, wherein the second location is a file external to the paper, and wherein the file includes audio signal information"). See column 7, lines 11-24. The remaining limitations recite similar limitations and therefore, are rejected under similar rationale to that of independent claim 1.

In reference to dependent claim 21 and 22, Schilit teaches:

The control routine analyzes the context of the annotation and generates a query that will be used to search the database of target portions. The system and method of this invention derives the query from the text of the annotated passage and from the nature of the annotation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the well-known context analysis methods taught by Schilit to create annotations pointing out advertisements or any other text that would be appropriate to a user's interest and creating a link to that advertisement if that was of interest to a specific user for minimizing the explicit query required to identify portions of other documents.

In reference to dependent claim 23, Schilit teaches:

It is to be understood that the term annotation as used herein is intended to include text, digital ink, audio, video or any other input associated with a document. It is also to be understood that the term document is intended to include text, video, audio, and any other media and any combination of media. See column 7, lines 11-24.

In reference to dependent claim 24 and 25, 26-28, the system claims reflect similar limitations to those found in independent claim 19-23, therefore, the claims are rejected under similar rationale.

In reference to claims 29 and 30, the computer program product claims found in claims 29 and

30, recite similar limitations to those found in claims 19 and 20. Therefore, the claims are

rejected under similar rationale.

Response to Arguments

6.   Applicant's arguments with respect to claims 1, 2, 4-7, 9-12, and 14-30, have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

ML